

**REMARKS/ARGUMENTS**

Claims 7, 9-13, 25, and 27-39 remain in this application. Claims 3-6, 8, 21-24, and 26 have been canceled without prejudice, and Applicants reserve the right to pursue such claims in continuation applications. Claims 7 and 25 have been rewritten in independent form and amended to recite the limitations of claims 8 and 26, respectively.

**REJECTION UNDER 35 USC 112, FIRST PARAGRAPH**

**I**

Claim 3-13 and 21-31 were rejected under 35 USC 112, first paragraph. See Pages 3-5 of the Office Action. According to the Office Action, "the specification while being enabling for the use of the polynucleotide 1 to about 3958 or 3910 of SEQ ID NO:15 as a promoter sequence activating the transcription of a polynucleotide encoding a polypeptide, does not provide enablement for either making a variant of said polynucleotide comprising modifications of 1 – 50 bases or for using said polynucleotide or its variant for any other use." See Page 3 of the Office Action. Applicants respectfully disagree. As stated on page 4 the Office Action, "recombinant and mutagenesis techniques are known." The specification sets forth assays in which to test the resulting polynucleotide sequence for promoter activity. There is no requirement that the variant polynucleotides have equivalent or even superior activity, only that they have some activity. Applicants assert that it would not be undue experimentation to make deletions, additions, insertions, and/or substitutions of from 1 to 50 bases of the recited sequences, and determine whether such variant sequences possessed activity. Accordingly, Applicants respectfully request that the above rejection be withdrawn.

**II**

Claims 3-7, 12, 21-25, and 30 were also rejected under 35 USC 112, first paragraph "as containing subject matter which was not described in the specification in such as way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention." See Pages 5-6 of the Office Action. Applicants respectfully disagree. However, as described above, Applicants in the interests of furthering the

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above application to allowance, have amended claims 7 and 25 to recite the limitations of claims 8 and 26, respectively. All of the remaining claims depend from one of these independent claims. Accordingly, Applicants respectfully request that the above rejection be withdrawn.

**REJECTION UNDER 35 USC 102**

Claims 3-7, 12, 21-25, and 30 were rejected under 35 USC 102(a) as being anticipated by Birren et al. See Pages 6-7 of the Office Action. Applicants respectfully disagree, but in the interests of furthering the above application to allowance, Applicants have amended independent claims 7 and 25 to recite the limitations of claims 8 and 26 respectfully. All of the remaining claims depend from one of these independent claims. Accordingly, Applicants respectfully request that the above rejection be withdrawn.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

By: 

William E. McGowan  
Reg. No. 39,301

Johnson & Johnson  
One Johnson & Johnson Plaza  
New Brunswick, NJ 08933-7003  
(732) 524-2197  
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